02-02-07

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Whitman, Robert E. **Group Art Unit:** 1734

Serial No.: 10/ 618,691 **Examiner:** Sing Chan

SUPPLEMENTARY BRIEF ON APPEAL

To: The Commissioner of Patents & Trademarks
Washington, D.C. 20231

Sir:

This is an appeal from the final rejection of claims 1,2 and 3 of the subject application. No claims have been allowed in this action.

02/05/2007 AWONDAF1 00000095 10618691

01 FC:2402 250.00 OP
02 FC:2255 1080.00 OP

Enclosed is a check in the amount of $250.00 for filing this brief in support of the appeal. (A check for an extension fee for five months in the amount of $1080.00 is also enclosed.)

1. Real party in interest

The listed inventor Robert E. Whitman is the real parties in interest in the application herein.

2. Appeals and interferences

Appellant knows of no other appeals or interferences which will affect or be directly affected by or have a bearing on the Board's decision herein.

3. Status of claims

Of the claims 1,2 and 3 in the application, all said three claims are under final rejection.

4. Status of Amendments

Amendment number 1 has been entered.

Claim Grouping

A process of applying an adhesive for rubber roofing sheets having bottom surfaces comprised of spraying on a roof upper surface in an even layered film an adhesive product comprised of the following components in the following delineated percentages:

(a) synthetic rubber and resin (37%);

(b) toluene (10%);

(c) cyclohexane (29%);

(d) dearomatised petrol (24%);

and after application of such adhesive product on said roof upper surface, placing said bottom surfaces of said rubber roof sheets over said adhesive product on said roof upper surface.

Issue

The issue in this appeal is whether the references cited as rejections under the provisions of 35 U.S.C. 102 and 35 U.S.C. 103 in view are subject to being barred from allowance (claims 1 and 2-under 35 U.S.C. 103 and claim 3-under 35 U.S.C. 102) in view of the fact that no reference alone or in combination sets forth the combination of components set forth in applicant's claims as sprayed on a roof. Accordingly, it is submitted that Appellant's claimed invention is not disclosed or suggested in the art cited and the claims under issue are rejected in error.

Summary of Invention

The subject invention is a process for applying adhesive product for adhering roof covering sheets to the upper surface of a building, such process comprising applies in the following products in various combination ratios:

(a) synthetic rubber and resin;

(b) toluene;

(c) cyclohexane;

(d) dearomatised petrol

With such product being applied by utilizing a spraying device to apply such product in an even layered film and then adhering to the bottom surfaces of a roofing sheet over such applied film. This positioning of the rubber roof sheets is preferably consummated immediately after the application of the adhesive product. Additionally certain other compounds may be added to the above product to minimize the viscosity of the product and render the product more compatible with the environment.

In using this general formulation to apply rubber roof sheets or other types of roof sheets to the upper surface of a roof, the product and process above described generates a less viscous adhering substance that can for a given volume of advance can cover, in some situations approximately ten times the surface area that existing adhering products are capable of covering. This aspect therefore means that a given volumetric unit of the subject product can replace a larger quantity of the existing adhering products to accomplish the same end result if adhering roofing sheets. Additionally, the subject product as applied with the given process, as generally described has a substantially greater adhering capability and strength, with longer lasting adhering effects.

Further, in using the subject product there is no necessity to use a high pressure sprayer to apply the adhesive material by reason of a lower viscosity and no need use expensive time consuming procedures to clean the sprayer after each use. Indeed, most low pressure sprayers will be adequate to accomplish the spraying process in applying the subject adherent. Further the adhering substance herein can also be used to spray and coat the insulation material used in the roofing infrastructure in order to protect the integrity thereof. The environmentally compatible aspects are such that the composition is easy to disintegrate into a relatively harmless way into the environment.

An additional attribute of this product is that the substance herein dries more quickly without bubbling and as a result the roofing sheets can be applied more quickly so as to render the overall adhesive and installation process more efficient, with the end product having a greater adhesive quality.

Argument

Claim 3 was rejected under 35 U.S.C. 102(b) as anticipated by, Klein (U.S. Patent No. (2,459,357). Applicant has reviewed the action of the Examiner in which it is stated:

> "Kalwara et al discloses a method for applying rubber onto a roof. The method includes providing an adhesive comprising polychloroprene rubber polymer, monoolefin based rubber polymer, tackifier resins, and depending on the particular polymers used, a combination of solvents such as cyclohexane, toluene, and n-heptane are used to form a flowable adhesive composition, applying the composition by straying onto a roofing substrates and applying the a roofing membranes to the applied adhesive. (Col 2, lines 24-32, Col 4, lines 10-45, Col 4, line 55 to Col 5, line 2) Kalwara et al is silent as to the solvent includes dearomatized petro. However, providing dearomatized petrol or gasoline as a solvent is well known and conventional as shown for example by Gaile et al. Gaile et al teaches the fact that n-heptane and dearomatized gasoline are shown to be equivalent for use as non-polar solvents. (See English abstract of RU 2, 221, 836)
>
> It would have been obvious to one of ordinary skill in the art at the time the invention was made to use dearomatized gasoline as a non-polar solvent as disclosed by Gaile et al in the method of Kalwara et al because these two materials are art recognized as equivalents". (See Kalwara et al, Col 4, lines 21-28)"

A review of the above referenced patent indicates that there is no disclosure of the components including dearomatized petrol, culohexaol and toulene, as such. The reference patent discloses two main components namely rubber polymers and resin (as does Applicant's disclosure and other solvents. Kalwara does not disclose the use of both solvents cyldhexana and toulene-nor does it disclose the use of dearomatized petrol. It is suggested by the Examiner that the Russel Patent (2,221, 836) teaches the use of "dearomatized gasoline" in an overall bimodal liquid extraction process for processing of

petroleum "for purifying cacumn gas "oil"in order to remove aromatic hydrocarbons, as well as heteroatomic components, and heavy metal compounds.

Thusly, it can be seen the use of dearomitzed petroleum as disclosed in Russin Patent (2,221,838) is directed entirely to a different process art and end use-not related to the process shown in Kalwara or Applicant's disclosure. It would thus appear that the parameters of 35 USC103 would not be applicable under such circumstances. Additionally, the unique nature of Applicant's process yields coverage of a superior product that yields approximately nine times the surface area as before.

Claim 1 and 2 are presently rejected by the Examiner under 35 U.S.C. 103 (a), which reads as follows:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that he subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negative by the manner in which the invention was made.

Accordingly, it is clear that appellant's claimed invention is not disclosed or suggested in the art cited. The CADC has held that a limitation cannot be met by an element or step or component in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept. (See RCA Corp. v. Applied Digital Data Systems, Inc., 221 P.Q. 385, 1984). The Federal Circuit further stated in relation to the Section 102 rejection that the prior art must disclose each and every element of the claimed invention. (SSIH Equipment S.A. v. United States International Trade Commission, 218 P.Q. 678, 1983).

With regard to the error in rejecting claims under 35 U.S.C. Section 103, again the references fail to disclose applicant's key elements. The fact that the prior art fails to suggest applicant's some structural features of applicant's invention that leads to a successful operation of the claimed device clearly suggest non-obviousness. (In Re: Kaslow 217 P.Q. 1089, Fed. Cir. 1983). In contrast to appellant's invention is different. The mere fact that the references cited by the examiner may be modified does not allow the examiner to meet his or her burden absent a suggestion in the cited art of the desirability of the modification. (In re: Fritch, 23 P.Q. 2nd 7180 Fed Cir. 1992).

Conclusion

In conclusion, it is urged that the decision of the Examiner rejecting all claims in this case be reversed.

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Certificate of Mailing

This is to certify that a copy of the foregoing brief was mailed to the United States Patent Office Board of Appeals, P.O. Box 1450, Alexandria, VA 22313-1450 (C.O. Commission of Patents), U.S. Patent Office, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 1ST day of ~~November~~ FEBRUARY, 2006, by deposition same in the U.S. Mail by way U.S. Post Office via Express Mail No. EQ 011343029 U.S.

Robert E. Whitman